

REMARKS

Claims 1-22 are pending in the Application. All claims stand rejected. Form PTO-326 states that the specification is objected to. Presumably this relates to the notification that the drawings are informal. Claims 7, 8 and 12 are rejected under 35 U.S.C. 112, second paragraph as being indefinite. Claims 1-22 stand provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-18 of co-pending application no. 09/271,011. Claims 1-22 are further provisionally rejected in a like manner as being unpatentable over claims 1-20 of co-pending application no. 09/271,008. Claims 9, 11, 14, 19, 20 and 22 are rejected under 35 U.S.C. 102(e) as being anticipated by United States Patent No. 6,192,028 to Simmons, *et al.* (Simmons). Claims 1-8, 10, 12, 13, 15-18 and 21 stand rejected under 35 U.S.C. 103(a) as being unpatentable over Simmons in view of United States Patent No. 5,784,559 to Frazier, *et al.* (Frazier).

In response to the Action, claims 7, 8 and 12 have been amended to meet the Examiner's objections. The double patenting rejections are traversed. It is submitted that the Simmons apparatus cited in the rejection under 35 U.S.C. 102(e) is not the identical invention. It is further respectfully submitted that Simmons is not an effective base reference for a 35 U.S.C. 103(a) rejection and that the requirements of MPEP 2133.01 have not been met in order to make out a proper obviousness rejection. The rejections are addressed in the order they appear in the Action.

The Action states in paragraph 3 that in claim 7, lines 1 and 2, the buffer order and order of frame transmission lack antecedent basis and states further objections. Similarly, claims 8 and 12 include terms lacking antecedent basis. Further, claim 12

should depend on claim 10 rather than on claim 1. Applicants have amended each of the claims in question to meet each objection by the Examiner.

In paragraph 4 of the Action, claims 1-22 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-18 of co-pending application 09/271,011. The position is taken that although the “although the conflicting claims are not identical, they are not patentably distinct from each other because the claimed subject matter of claims 1-22 of the instant application encompasses the claimed invention of claims 1-18 of the above co-pending patent application.” To support this position, comparisons are made between claim 1 in each application. Applicants specifically traverse the position that a showing has been made that the claims are not patentably distinct. It seems that the wording of the claims is being used to indicate that the asserted conflict is self-evident. The manner in which one claims’ being “encompassed” by the other has not been demonstrated. Applicants further assert the same traversal with respect to the rejection in paragraph 5 regarding co-pending claims 1-20 of application no. 09/271,008. However, Applicants note that this rejection is provisional.

Next, claims 9, 11, 14, 19, 20 and 22 are rejected under 35 U.S.C. 102(e) as being anticipated by Simmons. Claim 9 is briefly reviewed. This claim recites a buffer having a plurality of records and a network interface coupled to the buffer to receive a plurality of frames from a plurality of communication links, to store the frames in a corresponding plurality of records within the buffer *in order of receipt*, and to assign a pointer value of each of the plurality of records denoting a relative order of frame transmission of each of the plurality of frames. Note that in Applicants’ specification at page 4, Applicants state that “[A] method for preserving frame order across multiple physical lengths between a source and destination node(s) is presented ...” Note that in the field of invention, Applicants state that the invention relates to a method and apparatus for preserving frame

ordering. It is respectfully submitted that Simmons does not teach the physical apparatus as suggested in paragraph 6 of the action and that Simmons does not address the problem of maintaining frame order between source and destination nodes. He does not teach the same invention.

The Action characterized Simmons as having a buffer 32. At column 5, lines 41-44, Simmons states that a SDRAM interface 32 provides access to an external memory for storage of received frame data, memory structures and MIB counter information. The Action states that a network interface 28, 42, 66 and 70 coupled to the buffer receive a plurality of frames from communication links to store the frames in a corresponding plurality of records. The Action further characterizes this storage as being within the order of receipt and cites column 7, lines 47-56 as supporting this proposition. Further, the Action states that at column 8, lines 21-43 Simmons assigns a pointer value to each of the plurality of records denoting a relative order of frame transmission of each of the plurality of frames.

It is respectfully noted that column 7, lines 47-56 and column 8, lines 21-43 of Simmons do not make this teaching. Data packets are indeed output to the external memory 34 from a FIFO 64. At column 6, lines 29-46, Simmons points out that an internal rules checker 68 and an external rules checker 44 provide decision making logic for determining the destination port for a given data packet. Each packet includes a header having source and destination address, where the decision making engine may identify the appropriate MAC port based upon the destination address. In the cited passage in column 7, Simmons only states that the rules checker, based on the information in the header determines from where the frame will be cast, i.e., through which port or ports will the frame be transmitted. In the cited passage at column 8, the rules checker 42 or 68 places a port vector in corresponding frame pointer into a port vector FIFO 63, which will determine into which particular output queue 67 (or queues)

the frame pointer associated with the port vector should be input. Simmons clearly teaches directing successive frames to specific queues. Simmons does not teach maintaining frames in order as recited by Applicants. Indeed, in Figure 3, Simmons discloses a plurality of queues 67 to which frames may be directed. This is significant in Simmons' structure since, as Simmons clearly explains, at column 2, lines 1-13 that he is seeking to avoid dropped data packets. Also Simmons selectively generates flow control signals based on a buffer capacity of an output port serving a destination station.

Simmons in fact does not teach assigning a pointer value to each of a plurality of records denoting a relative order of frame transmission. It is useful to do a word search in the text of Simmons. Order is only discussed at column 6, lines 50-56. This passage states,

Use of the external rules checker 44 provides advantages such as increased capacity, a random-based ordering in the decision queue that enables frame forwarding decisions to be made before the frame is completely buffered to external memory, and enables decisions to be made in an order *independent from the order in which the frames were received by the multiport switch 12.* (Emphasis supplied.)

If indeed Simmons is working to keep frames in order, as recited by Applicants, there would be no decisions to be made in an order independent from the order in which the frames were received by the multiport switch 12. Simmons is seeking to select different paths for the frames to avoid dropped packets. The Action recites further specifics of Simmons disclosure with respect to claims 11 and 14. In neither case does Simmons teach keeping frames in order. Fetched data may be loaded into a FIFO, however, there is no teaching in Simmons as to the order in which the fetched data is delivered to the FIFO. Claims 19 and 20 are rejected by the same rationale, because the claims call for an intended use about the apparatus of claims 9-11 and 14 in a multi-link trunk network. This rejection is traversed because these claims specifically recite assigning a pointer value to each of the plurality of records denoting the relative order of frame transmission.

It is thus submitted that the 102 rejection on Simmons merits withdrawal. MPEP 2131 requires patent anticipating reference disclose the identical invention. As explained above, Simmons does not.

In paragraph 7 of the action, claims 1-8, 10, 12-13, 15-18 and 21 stand rejected under 35 U.S.C. 103(a) as being unpatentable over Simmons in view of Frazier. As explained above, Simmons does not teach the flow control method for preserving order of a plurality of frames. It is important to note preserving frame order of a plurality of frames in language that comes only from Applicants' specification. It is not found in Simmons, specification. It is not found in Frazier. Indeed a word search on the Frazier patent in the PTO database indicates that the word "order" does not appear in the Frazier specification.

There are a number of deficiencies in the citation of Frazier. First, the Action states that Frazier at column 6, lines 6-9 and column 9, line 31 to column 10, line 24 and column 13, lines 39-42, Frazier discloses that when RX_DV is inserted on the MII, process data can be passed to a logical layer. This is not the same as denoting the start of a frame transmission on a corresponding plurality of links. Indeed, there is no teaching in the phrase of the disclosure of an output line that provides a useful signal indicative of frame transmission and that has a reason for being there. Frazier in the abstract as cited in the Action, teaches that RX_DV provides a received carrier sense signal that frames data within the MAC receive process. Consequently, the teachings cited by the Examiner relate to actually creating frames of data rather than processing existing data frames as claimed by Applicants. Frazier specifically teaches that the present invention provides process deferral and data framing preferably using two independently generated signals. Frazier is not combinable with Simmons since Simmons is already dealing with frame data that is already in the form of frames.

Next, MPEP 2143.01 states that there must be a motivation *in the art to combine these two references*. There is no suggestion of any shortcoming in Simmons which could be cured by Frazier. There is no suggestion that Frazier itself states that it could be used in the context of Simmons. The only teachings in the record for combining the features taken out of context from Simmons and Frazier are found in Applicants' claims. The Board of Appeals and Interferences does not permit a rejection based on using Applicants' claims as a guideline.

The Action also says "thus it would have been obvious to a skilled artisan at the time of the invention to implement Frazier's teaching into Simmons' method to provide a flow control method for a full duplex Ethernet network as well as increasing the network capacity. MPEP 2143.01 also states, "FACT THAT THE CLAIMED INVENTION IS WITHIN THE CAPABILITIES OF ONE OF ORDINARY SKILL IN THE ART IS NOT SUFFICIENT BY ITSELF TO ESTABLISH *PRIMA FACIE* OBVIOUSNESS" (emphasis in original).

With all due respect, it is also submitted that it strains credulity to think that one skilled in the art somehow selecting Frazier to read would decide that creating a frame teaches detecting the beginning of a frame. The Action takes notice that this is possible. Under the authority of the MPEP 2144.03, a reference for this proposition is requested. Similarly, a reference is requested that it was within the ordinary skill in the art to decide to provide a full control mechanism for a full duplex Ethernet network in a context like Simmons.

What is being done here is that a high level of skill in the art is being invoked, and that alone is the basis in this paragraph of the rejection for suggesting the combination. The Court of Appeals for the Federal Circuit has held that this is an impermissible form of rejection. *In re Rouffet*, 149 F.3d 1350, 47 U.S.P.Q. 2d 1453 (CAFC 1998). The court

said, "Because the Board did not explain the specific understanding or principle within the knowledge of a skilled artisan that would motivate one with no knowledge of [Applicants'] invention to make the combination, this Court infers that the Office Action selected these references with the assistance of hindsight. This Court forbids the use of hindsight in the selection of references that comprise the case obviousness." The Court went on to point out that while skill in the art is a component of inquiry for suggestion to combine, a lofty level of skill alone does not supply a motivation to combine. Otherwise a high level or ordinary skill in an art field will almost always preclude patentable inventions.

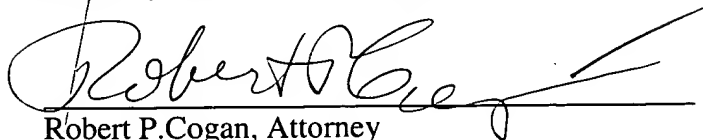
The Action states that claims 10, 12, 13, 15-18 and 21 are rejected under the same rationale. Therefore, it is submitted that the rejection as to these claims be withdrawn for the same reasons.

Summarizing, it is respectfully submitted that there is no disclosure in Frazier to serve as the basis for anticipation or as a base reference it is further submitted that the record does not support the position that Frazier teaches detection of the beginning of frame signal. Further, even if Frazier did have such a teaching, there is not motivation in the art of record to suggest the combination. It is therefore respectfully submitted that the rejections merit withdrawal. Further, Applicants have completely replied to the Examiner's requirements for correction of the claims to comply with 35 U.S.C. 112. The undersigned would be pleased to receive a telephone call from the Examiner for the purpose of advancing the issues. Favorable action is therefore earnestly solicited.

Respectfully submitted,

BLAKELY, SOKOLOFF, TAYLOR & ZAFMAN LLP

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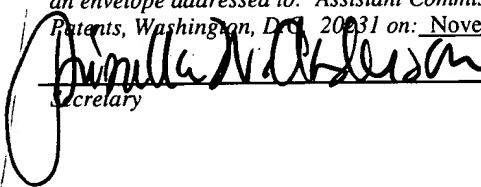


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11/19/01
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VERSION WITH MARKINGS TO SHOW CHANGES MADE

In the Claims

7. (Amended) The method of claim 1 [wherein] comprising storing records in the buffer in an order which does not correspond to the order of frame transmission of the records.

8. (Amended) The method of claim 1 [wherein] further comprising reading the plurality of frames [are] out of the buffer in accordance with their pointer value, [which is different that the] in an order different from an order in which the frames are stored in the buffer.

12. (Amended) The apparatus of claim [9]10, wherein the indication is an analog indication.

22. (Amended) The network device of claim 19, wherein the network interface promotes each of the plurality of frames stored in the buffer to a system state in order of pointer value, [irregardless] irrespective of an order in which they are stored in the buffer.